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Patent
Attorney's Docket No. 006450-367

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
	)	
ALAIN A. MEILLAND	)	Group Art Unit: 1661
	)	
Application No.: 09/933,176	)	Examiner: Howard J. Locker
	)	
Filed: August 21, 2001	)	Confirmation No.: 6434
	)	
For: FLORIBUNDA ROSE PLANT NAMED 'MEICHIBON'	)	

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the May 6, 2003 Official Action, Applicant respectfully requests reconsideration.

It is noted with appreciation that the previous rejection under 35 U.S.C. § 112 has been withdrawn.

The continued rejection of the claim under 35 U.S.C. §102(b) is urged to be incapable of withstanding detailed analysis for the reasons set forth in detail in Applicant's submission of February 28, 2003. For a plant to enter the public domain one must look to the statutory language as it has existed and been interpreted for over seventy years. There must be public use or sale in the United States for a sufficient time prior the United States filing date in order to create a statutory bar. This has not occurred as indicated in

Applicant's submission of February 28, 2003. The Examiner has cited no authority for assertion that the availability an invention outside the United States combined with a non-enabling publication has ever been used to create a statutory bar other than the *Ex parte Thomson* decision. For the reasons indicated in Applicant's submission of February 28, 2003, the controlling authority continues to be the *In re LeGrice* decision that was rendered by the Court of Customs and Patent Appeals. A factual situation directly comparable to that of the present Application was there presented and patentability was found. It respectfully is submitted that there is no sound reason for Patent Office personnel to put forth at this time a different interpretation of the statute from that which has been consistently followed for decades. Such new interpretation is urged to be inappropriate as well as unfair to Applicant.

Plant publications should be disregarded when making a patentability analysis with respect to a new plant variety unless they can be combined with the existing scientific "store of knowledge in the fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess" so as to enable another to produce the plant. The mere possibility to seek an invention in a foreign country and to bring it to the United States has never been an impediment to patent protection in any area of technology with or without the presence of a nonenabling publication in the absence of a showing that the invention was on sale or in public use in the United States more than one year before the United States filing date. As specified at 35 U.S.C. § 161, Plant Patents and Patents for

other inventions should be subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. The statute has been misapplied in the Official Action. Accordingly, the withdrawal of the sole remaining ground of rejection likewise is in order and is respectfully requested.

If any additional information is required please contact the undersigned attorney so that the matter can be discussed and resolved at a personal interview.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: August 6, 2003

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